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Thomas L. Irving FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P. 1300 I Street, N.W. Washington, DC 20005-3315				
EXAMINER				
VENKAT, JYOTHSNA A				
ART UNIT		PAPER NUMBER		
1615				
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08/11/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/821,919

Applicant(s)

DE LA POTERIE, VALERIE

Examiner

JYOTHSNA A. VENKAT

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-13, 18,21,24,28 and 32-34 is/are pending in the application.
- 4a) Of the above claim(s) 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-11,13,18,21,24,28 and 32-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 5/8/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of amendment, remarks, IDS and letter stating submission of English language translation of provisional application under 37 C.F.R. § 1.52(d)(2) filed on 5/8/08. Claims 14 and 31 have been canceled as per applicants' amendment dated 5/8/08. Claim 12 has been amended and it is drawn to non-elected subject matter and therefore it is withdrawn from consideration. Claims 1-3, 5-11, 13, 18, 21, 24, 28 and 32-34 are pending in the application. The generic claims will be examined to the extent that it reads on the elected species only.

The following new ground of rejection is necessitated by the amendment.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3, 5-11, 13, 18, 21, 24, 28 and 32-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is new matter rejection.**

There is no support in the specification for "fusion peak".

Claim Rejections - 35 USC § 102

Claims 1-3, 5-11, 13, 18, 21, 28 and 31-34 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent 3,911,105.

Specification teaches the measurement for measuring thermal profile. See below.

Determination of the thermal profile of the composition

[022] The thermal profile of the composition according to the present disclosure is determined using a differential scanning calorimeter (DSC), for example the calorimeter sold under the name DSC 30 by the company Mettler.

See paragraph bridging col.s 3-4 for the preferred homopolymers. The description included only 9 polymers. "POLYSTEARYL METHACRYLATE" is repeated twice. First occurrence should be polystearyl acrylate (claimed species) belonging to "at least one compound". See claim 5 for "elected species". see col.5, ll 37-40 for water (aqueous phase of claim 21) and see col.4, ll 49-65 for claim 28 drawn to dyestuff. See col.4, ll 25-27 for lip rouge and mascara, which reads on the claimed cosmetic composition. Mascara reads on claim 31. PTO is not equipped to measure the thermal profile and the limitations claimed in claims 2-11, therefore patent anticipates these claims. Since the components claimed are same to that disclosed, patent anticipates claim 33.

Response to Arguments

Applicant's arguments filed 5/8/08 have been fully considered but they are not persuasive.

Applicant argues:

"Applicant respectfully submits that the '105 patent does not anticipate the present claims, as it does not explicitly or inherently teach or suggest all of the claim limitations. Specifically, the '105 patent does not disclose, and further does not even suggest, any desired thermal profile or melting peak, and certainly not

"[a] cosmetic composition comprising ... at least one compound which gives the cosmetic composition a thermal profile having a melting peak wherein the mid-height width L_f is less than or equal to 20°C, the at least one compound having a thermal profile having a fusion peak wherein the mid-height width L_f is less than or equal to 20°C," as recited in amended independent claim 1. Further, the '105 patent does not disclose, or even suggest, any of "[a] cosmetic composition comprising ... at least one compound ... wherein the at least one compound is chosen from waxes and semi-crystalline polymers having a melting point ranging from 35°C to 65°C; ... wherein the at least one compound is present in the composition in an amount ranging from 5% to 60% by weight, relative to the total weight of the composition; ... and wherein said cosmetic composition is heat stable," as recited in amended independent claim 1.

The Examiner alleges that the composition disclosed in the '105 patent is the same as Applicant's claimed composition, and therefore that the thermal profiles of the '105 patent's composition and Applicant's claimed composition are the same. However, as the Examiner will appreciate, the properties of a composition necessarily vary depending on the components present in the composition and the amounts of these components. As discussed above, the composition of the '105 patent comprises "at least one cosmetic fatty body" in addition to the "at least one non-toxic polymer" which the Examiner contends is polystearyl acrylate. However, such a "cosmetic fatty body" is not present in the instant composition. Thus, the '105 patent clearly teaches an additional

component in the disclosed composition and, therefore, does not teach a composition identical to the present composition”.

In response to the above argument, patent '105 under claim 5 is claiming the homopolymers as “polystearyl acrylate”. This is the elected species belonging to claimed “at least one compound chosen from semi-crystalline polymers having a melting point between 35-65 degrees Celsius. The compound claimed in the patent is identical to that claimed in the instant application. Patent '105 under claim 1 is also claiming cosmetic composition like the instant application. Patent under claim 1 is claiming the homopolymers (polystearyl acrylate is the homopolymers) as 2-35% and the weight percent is within the weight percent claimed in the patent. Patent '105 under claim 8 is claiming the composition in the form of mascara and this is also claimed in the instant application. Patent under claim 9 is claiming water and this is the claimed cosmetically acceptable medium. Patent 105 under claim 1 is claiming homopolymers belonging to formula II and claim 5 is claiming 4 species. Patent under claim is claiming dye, which is also claimed in the instant application. Thus patent '105 is claiming a mascara composition and patent is also claiming dye and this is also claimed in the instant application. Therefore patent '105 anticipates independent claim 1 and also claims 2-3, 5-11, 13, 18, 21, 28 and 31-34.

All the components claimed in the instant application are also claimed in the patent therefore the composition claimed in the patent would also have the same thermal profile. Note that PTO is not equipped to determine the thermal profile by heating an empty crucible and a crucible containing a sample of the claimed composition.

Applicant also argues:

“The Examiner alleges that the composition disclosed in the '105 patent is the same as Applicant's claimed composition, and therefore that the thermal profiles of the '105 patent's composition and Applicant's claimed composition are the same. However, as the Examiner will appreciate, the properties of a composition necessarily vary depending on the components present in the composition and the amounts of these components. As discussed above, the composition of the '105 patent comprises "at least one cosmetic fatty body" in addition to the "at least one non-toxic polymer" which the Examiner contends is polystearyl acrylate. However, such a "cosmetic fatty body" is not present in the instant composition. Thus, the '105 patent clearly teaches an additional component in the disclosed composition and, therefore, does not teach a composition identical to the present composition”.

In response to the above argument, the expression “comprising” in the instant claims includes “at least one cosmetic body” disclosed and claimed in the patent since the use of the term “comprising” permits the presence of other ingredients and does not preclude the presence of other ingredients, active or inactive, even in major amounts. Moleculon Research corp., v. CBS, Inc., 793 F. 2d 1261, 229 USPQ 805 (FED. Cir. 1986); In re Baxter, 656 F. 2d 679, 210 USPQ 795, 803 (CCPA 1981).

Claim Rejections - 35 USC § 103

Claims 1-3, 5-14, 18, 21, 24, 28 and 31-34 rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 3,911,105 (‘105) and 6,875,245 (‘245).

Patent '105 teaches cosmetic composition using polystearyl acrylate, aqueous phase and dyestuff and use these compositions in the form of lipstick and mascara. Patent does not teach the limitation of claim 24, wherein the composition further comprising film-forming polymer, which is gum arabic. Patent '245 teaches compositions in personal care products. Personal care products are also known as cosmetic compositions. Patent '245 under examples 8-9, 25 and 66 teaches mascara compositions using gum arabic. Thus both the patents teach individually mascara compositions using polystearyl acrylate and gum arabic.

Accordingly it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare third composition and use it for coating keratin fibers (mascara) by combining the two components polystearyl acrylate and gum arabic with the reasonable expectation of success that the third composition is also effective for coating the keratin fibers. It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art.

Response to Arguments

Applicant's arguments filed 5/8/08 have been fully considered but they are not persuasive.

Applicant argues:

“Applicant has already established that the '105 patent does not anticipate Applicant's invention, as recited in amended independent claim 1. In addition, the '105 patent also fails to suggest Applicant's invention, at least for the reason that

the '105 patent discloses the use of homopolymers, namely a homopolymer having repeating units of the formula (I) and a homopolymer having repeating units of the formula (II). See '105 patent, Abstract. The '105 patent thus does not disclose or suggest the use of the elected semi-crystalline polymers, which are copolymers, and certainly does not disclose or suggest use of the claimed "at least one compound ... chosen from waxes and semi-crystalline polymers having a melting point ranging from 35°C to 65°C," as recited in amended independent claim 1.

As Applicant set forth in the specification, "the term 'semi-crystalline polymer' means polymers comprising at least one crystallizable portion, chosen from crystallizable pendent chains and crystallizable blocks, in the skeleton, as well as an amorphous portion in the skeleton ... [wherein] [t]he at least one crystallizable block is then of a different chemical nature from the at least one amorphous block." Specification at paragraph [0042], emphasis added.

Thus the homopolymers, and moreover, the fatty compositions disclosed by the '105 patent, cannot disclose or suggest Applicant's invention, as recited in amended independent claim 1.

Further, as discussed above, the '105 patent does not suggest any desired thermal profile or melting peak, and certainly does not suggest "[a] cosmetic composition comprising ... at least one compound which gives the cosmetic composition a thermal profile having a melting peak wherein the mid-height width Lf is less than or equal to 20°C," or "the at least one compound having a thermal profile having a fusion peak wherein the mid-height width Lf is less than

or equal to 20°C," as recited in amended independent claim 1. Moreover, the '105 patent does not suggest "the at least one compound ... having a melting point ranging from 35°C to 65°C ... [and] present in the composition in an amount ranging from 5% to 60% by weight, relative to the total weight of the composition; ... and wherein the cosmetic composition is heat-stable," as also recited in amended independent claim 1".

In response to the above argument, patent '105 discloses the use of non-toxic polymer selected from the group consisting of homopolymers, namely a homopolymer having repeating units of the formula (I) and a homopolymer having repeating units of the formula (11). See the abstract. Thus the polymer can be either homopolymers of formula I or homopolymers of formula II. Patent '105 discloses the use of the elected semi-crystalline polymers, which are copolymers, and certainly does disclose use of the claimed "at least one compound ... chosen from waxes and semi-crystalline polymers having a melting point ranging from 35°C to 65°C," as recited in amended independent claim 1 since the elected species belonging to semi-crystalline polymer is "polystearyl acrylate". Waxes belonging to "at least one compound" is drawn to non-elected subject matter.

Claimed desired thermal profile or melting peak, and claimed cosmetic composition comprising ... at least one compound which gives the cosmetic composition a thermal profile having a melting peak wherein the mid-height width L_f is less than or equal to 20°C," or "the at least one compound having a thermal profile having a fusion peak wherein the mid-height width L_f is less than or equal to 20°C," as recited in amended independent claim 1 is inherent since the composition claimed having the semi-crystalline polymer and physiologically medium is

disclosed in the patent . See detailed explanation under 102 (b) rejection. Patent '105 patent does disclose suggest "the at least one compound ... having a melting point ranging from 35°C to 65°C ... [and] present in the composition in an amount ranging from 5% to 60% by weight, relative to the total weight of the composition; ... and wherein the cosmetic composition is heat-stable," as also recited in amended independent claim 1 since patent'105 also claims composition using then same " polystearyl acrylate" a cosmetic composition and physiologically accepted medium (water).

Applicant also argues:

The Examiner relies on the '245 patent to overcome the deficiencies of the '105 patent. However, the '245 patent merely discloses "[a] resin composition ... prepared by reacting components comprising dibasic acid, diamine, polyol and monoalcohol." Abstract. The compounds disclosed in the '245 patent, namely ester-terminated poly (ester-amides) (ETPEA), have a softening point of 76.7° and 74.7°C, as disclosed in Examples A and B of the '245 patent. See col. 44, line 33 through col. 45, line 4. Thus, the compounds disclosed in the '245 cannot disclose or suggest the claimed cosmetic composition comprising at least one compound "... having a melting point between 35°C and 65°C," _as recited in amended independent claim 1. Further, the '245 patent fails to disclose or suggest any desired thermal profile or melting peak, and certainly does not suggest "[a] cosmetic composition comprising ... at least one compound which gives the cosmetic composition a thermal profile having a melting peak wherein the mid-height width Lf is less than or equal to 20°C," or "the at least one compound

having a thermal profile having a fusion peak wherein the mid- height width L_f is less than or equal to 20°C," as recited in amended independent claim 1. The '245 patent also fails to disclose or suggest "the at least one compound is present in the composition in an amount ranging from 5% to 60% by weight, relative to the total weight of the composition; ... and wherein the cosmetic composition is heat-stable," as also recited in amended independent claim 1. Moreover, neither reference separately nor combined provide motivation to arrive at a composition as presently claimed. Therefore, the teachings of the '105 and '245 patents, separately, or even if combined as the Examiner suggested, do not render obvious Applicant's invention, as recited in amended independent claim 1".

In response to the above argument, patent '245 was relied for the limitation of claim 24. Claim 24 includes a film-former and the elected species is "gum arabic". Instant application is claiming a mascara composition and both the patents relied for 103 rejection is drawn to mascara compositions. Therefore it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare third composition and use it for coating keratin fibers (mascara) by combining the two components polystearyl acrylate taught by patent '105 in mascara compositions and gum arabic taught by patent '245 in mascara compositions. One of ordinary skill in the art would have reasonable expectation of success that the third composition is also effective for coating the keratin fibers. It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art. The expression "comprising" in the

claims in the instant claims includes “at least one cosmetic body” disclosed and claimed in the patent ‘105 and ester-terminated poly (ester-amides) (ETPEA) disclosed in ‘245 patent since the use of the term “comprising” permits the presence of other ingredients and does not preclude the presence of other ingredients, active or inactive, even in major amounts. Moleculon Research corp., v. CBS, Inc., 793 F. 2d 1261, 229 USPQ 805 (FED. Cir. 1986); In re Baxter, 656 F. 2d 679, 210 USPQ 795, 803 (CCPA 1981).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /
Primary Examiner, Art Unit 1615